



## UNITED STATES, DEPARTMENT OF COMMERCE

## Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/335,376	06/17/99	L1M	J 01997/253005

<input type="checkbox"/>	TM02/0314	<input type="checkbox"/>	EXAMINER
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G ROGER LEE ESO  
FISH & RICHARDSON PC  
225 FRANKLIN STREET  
BOSTON MA 02110-2804

<input type="checkbox"/>	SMITS, T
ART UNIT	PAPER NUMBER

2641

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DATE MAILED: 03/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

	Application No.	Applicant(s)
	09/335,376	LIM, JAE S.
Examiner	Art Unit	
Talivaldis Ivars Smits	2641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 02 February 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) See Continuation Sheet is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-8 is/are allowed.
- 6) Claim(s) 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, and the rest is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- |  |   |
|--|---|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ .<br>19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>20) <input type="checkbox"/> Other: _____ |
|--|---|

Continuation of Disposition of Claims: Claims pending in the application are 1-9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153.

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Office Action mailed July 26, 2000, applicants have submitted an Amendment, filed February 2, 2001, amending claim 86 without adding new matter, and arguing to traverse the objection to the reissue declaration and the recapture estoppel claim rejections.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive, for the following reasons:

3. Applicant's supposed example of the requested at least one specific error does not directly explain what the error is (i.e., what unnecessary limitations were inadvertently imposed).

Even if the implied error in question were spelled out, the examiner insists that claim 69 has drastically broadened the previous claims. It merely recites subdivision of signal elements (actually "transform elements" after the Preliminary Amendment, but it's the same difference, since that's what it's all about) into subbands and providing the appropriate bookkeeping information, which is the inherent or explicit preprocessing being done in all the independent claims of the related applications, all of which recite subband coders. Thus the Reissue Declaration is still defective.

4. As for the source of the limitations in examiner's "long list" (Amendment, p. 4), they are all paraphrased from applicant's persuasive arguments for allowability of the therein listed claims for each limitation, in Amendments to the respective applications. Applicant has not argued that any of the limitations were not crucial for making the respective claims allowable, nor indicated which alternative limitations instead supposedly were the critical ones, apart from the ones the examiner listed. Thus, the examiner maintains his improper recapture rejection of all the new claims.

5. As for the alleged narrowing in material respects of the new claims (Amendment, p. 4), examiner finds none. Neither has applicant cited any specific limitations as providing such a narrowing. The inherent preprocessing limitations of claim 69 do not contain any narrowing, for reasons given above.

*Improper Recapture*

6. All of the new claims, i.e., claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153, are rejected under 35 U.S.C. 251 as being an improper recapture of subject matter deliberately surrendered in the application for the patent upon which the present reissue is based and its parent applications, for reasons given in paragraphs 5 and 6 of the previous Office Action (Paper No. 12).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. **Any response to this action should be mailed to:**

Box AF  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or FAXed to:**

(703) 305-9508 or 308-6306 or 308-6296 (for informal or draft communications, please label "PROPOSED" or "DRAFT"; for formal communications, please label "EXPEDITED PROCEDURE")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

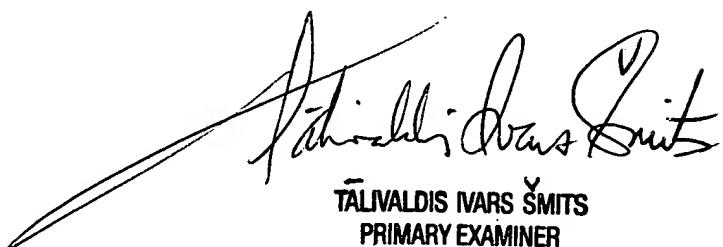
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

As of October 2, 2000 the former Technology Center 2700 has been split into two centers (TC 2100 and TC 2600), and former Art Unit 2741 has been designated as **Art Unit 2641**, which new AU number should be used in all future correspondence.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch, can be reached on (703) 305-6137. The facsimile phone numbers for Technology Center 2600 are (703) 305-9508, 308-6306, and 308-6296.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 receptionist, whose telephone number is (703) 305-4700

Art Unit 2641  
March 13, 2001



TALIVALDIS IVARS SMITS  
PRIMARY EXAMINER